



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/001,992 | 12/05/2001 | Ritsuko Tanaka | 1086.1152 | 2820 |
| 21171 | 7590 | 04/08/2004 | EXAMINER | |
| STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | YOUNG, JOHN L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3622 | |

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,992

Applicant(s)

RITSUKO ET AL

Examiner

John L Young

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

FIRST ACTION REJECTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTION — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3622

2. Claims 1-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Perkowski 6,064,979 (May 16, 2000) (herein referred to as "Perkowski").

As per claim 1, Perkowski (the ABSTRACT; FIG. 1; FIG. 1A; FIG. 1B; FIG. 2A1; FIG. 4A; col. 1, ll. 12-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-63; col. 5, ll. 7-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-59; col. 17, ll. 1-67; col. 18, ll. 1-67; col. 19, ll. 1-67; col. 20, ll. 1-67; col. 21, ll. 1-67; and col. 22, ll. 1-10; and whole document) shows the system of claim 1.

Perkowski lacks an explicit recital of the elements of claim 1 even though Perkowski shows same. It would have been obvious to one of ordinary skill in the art at the time of the invention that Perkowski (the ABSTRACT; FIG. 1; FIG. 1A; FIG. 1B; FIG. 2A1; FIG. 4A; col. 1, ll. 12-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-63; col. 5, ll. 7-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-59; col. 17, ll. 1-67; col. 18, ll. 1-67; col. 19, ll. 1-67; col. 20, ll. 1-67; col. 21, ll. 1-67; and col. 22, ll. 1-10; and whole document) would have been selected in accordance with the elements and limitations of claim 1 because claim 1 suffers from undue breadth and because selection of such features would have provided "such a system, wherein during the 'UPSN Search Mode' of the system, a predesignated information resource (e.g., advertisement, product information, etc.) pertaining to any commercial product or service registered with the system can be automatically accessed from the Internet and displayed from the Internet browser by simply entering the

registered product's trademark(s) and/or associated company name into the Internet browser." (See Perkowski (col. 4, ll. 5-15).

As per claim 2, Perkowski (the ABSTRACT; FIG. 1; FIG. 1A; FIG. 1B; FIG. 2A1; FIG. 4A; col. 1, ll. 12-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-63; col. 5, ll. 7-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-59; col. 17, ll. 1-67; col. 18, ll. 1-67; col. 19, ll. 1-67; col. 20, ll. 1-67; col. 21, ll. 1-67; and col. 22, ll. 1-10; and whole document) shows the system of claim 2.

Perkowski lacks an explicit recital of the elements of claim 1 even though Perkowski shows same. It would have been obvious to one of ordinary skill in the art at the time of the invention that Perkowski (the ABSTRACT; FIG. 1; FIG. 1A; FIG. 1B; FIG. 2A1; FIG. 4A; col. 1, ll. 12-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-63; col. 5, ll. 7-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-067; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-59; col. 17, ll. 1-67; col. 18, ll. 1-67; col. 19, ll. 1-67; col. 20, ll. 1-67; col. 21, ll. 1-67; and col. 22, ll. 1-10; and whole document) would have been selected in accordance with the elements and limitations of claim 2 because claim 2 suffers from undue breadth and because selection of such features would have provided "such a system, wherein during the 'UPSN Search Mode' of the system, a predesignated information resource (e.g., advertisement, product information, etc.) pertaining to any commercial product or service registered with the system can be automatically accessed

from the Internet and displayed from the Internet browser by simply entering the registered product's trademark(s) and/or associated company name into the Internet browser." (See Perkowski (col. 4, ll. 5-15).

As per dependent claims 2-17, Perkowski shows the system of claim 1.

Perkowski lacks explicit recitation of the elements and limitations of claims 2-17, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 2-17 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 2-17, because selection of such features would have provided "such a system, wherein during the 'UPSN Search Mode' of the system, a predesignated information resource (e.g., advertisement, product information, etc.) pertaining to any commercial product or service registered with the system can be automatically accessed from the Internet and displayed from the Internet browser by simply entering the registered product's trademark(s) and/or associated company name into the Internet browser." (See Perkowski (col. 4, ll. 5-15).

Independent claim 18 is rejected for substantially the same reasons as independent claim 1.

Independent claim 19 is rejected for substantially the same reasons as independent claim

1.

Independent claim 20 is rejected for substantially the same reasons as independent claim

2.

Independent claim 21 is rejected for substantially the same reasons as independent claim

1.

Independent claim 22 is rejected for substantially the same reasons as independent claim

2.

CONCLUSION

3. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications **EXPEDITED PROCEDURE**) or (703)
746-7239 (for formal communications marked **AFTER-FINAL**) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

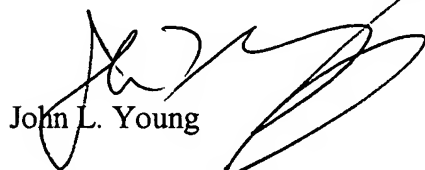
Hand delivered responses may be brought to:

Seventh floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


John L. Young

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Primary Patent Examiner

April 5, 2004